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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/594,142

11/21/2006

Hiromi Takarada

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EXAMINER

SALVATORE, LYNDIA

ART UNIT

PAPER NUMBER

1794

NOTIFICATION DATE

DELIVERY MODE

12/08/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

pto.phil@dlapiper.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/594,142	<b>Applicant(s)</b> TAKARADA ET AL.	
	<b>Examiner</b> LYNDA M. SALVATORE	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-15 is/are pending in the application.
- 4a) Of the above claim(s) 8-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Applicant's remarks filed 9/1/09 have been fully considered and entered.

Applicant's remarks are not found persuasive of patentability for reasons set forth herein below.

#### ***Claim Rejections - 35 USC § 102/103***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-3 and 5-7 stand rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Aranishi et al., US 6,984,631.

Applicant argues that the physical characteristics of glass transition point ( $T_g$ ) of 160°C or more, a strength of 1.3 to 4 cN/detex and a coefficient of variation in single yarn fineness of 10% or less as recited in Claim 1 are not "necessarily" the same as the physical characteristics of the Aranishi et al., melt-spun fibers as is required to maintain a rejection based on inherency. Applicant asserts that the instant fibers are produced in a different manner than the fibers of Aranishi et al. Specifically, Applicant submits that the plasticizer is removed from the fibers prior to heat set such that the resulting fibers are substantially free of water soluble plasticizers. As such, Applicant's assert that instant fibers have characteristics (e.g., glass transition temperature) different from the fibers of Aranishi et al. Applicant's example 1 in the specification observed a glass transition temperature of 185°C which is within the claimed range of 160°C or more. In contrast, Applicant points to comparative example 1 in the specification where a glass transition temperature of 115°C was observed. Applicant's assert that the reason for the

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difference in glass transition temperatures is because the fibers in comparative example 1 are produced in a manner which is consistent with the manufacturing process used to produce the fibers of Aranishi et al. (e.g., the plasticizer is not removed). These arguments are not found persuasive.

With regard to Applicant's argument that the instant fibers are produced differently from the fibers of Aranishi et al., it is respectfully pointed out that Applicant is not claiming a product by process. Applicant is not claiming a process which includes removing the plasticizer prior to heat set. Rather, instant claim 1 recites a woven fabric or a knitted fabric for clothing at least partly comprising cellulose acetate propionate continuous filament. As such, it is the position of the Examiner that the presence of plasticizer is not precluded from being present in the filament. In other words, Applicant's open claim language of comprising does preclude the presence of plasticizer. With regard to claim 5, the amount of plasticizer can range from 0-1.0 %. To that end, Aranishi et al., teach an amount ranging from 1-30 wt. % (column 3, 50-65). It is the position of the Examiner that Aranishi et al., meets the claim limitations.

With regard to Applicant's arguments that instant fibers are substantially free of water soluble plasticizers, it is respectfully pointed out that Applicant is not claiming such limitations. If the amount of or lack of plasticizer is critical to novelty of the cellulose acetate propionate fiber, then it is suggested that Applicant positively recite such limitations.

Applicant is reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Absent positive limitations directed to the amount of or lack of plasticizer, the Examiner maintains that the claimed physical characteristics are inherent to the fibers of Aranishi et al., even though the fibers of Aranishi et al., are produced by a different method.

The patent issued to Aranishi et al., teach a melt-spun fiber comprising a mixture of a thermoplastic mixed cellulose ester and a plasticizer (column 3, 60-65). Said mixed ester is cellulose acetate proprionate (column 10, 26-40). Aranishi et al., teach a degree of substitution of .5 to 2.9 per glucose unit (column 10, 41-45). Said plasticizer is in an amount ranging from 1-30 wt. % (column 3, 50-65). Said fibers also have a strength ranging from .7 to 3.8 cN/dtex (column 9, 1-10). Said fibers have a size ranging from .5-100dtex (column 9, 20-30). Aranishi et al., teach that the fibers exhibit excellent mechanical properties and uniformity and are well suited for clothing (column 15, 30-40, column 16, 54-60). Aranishi et al., teach forming a knit fabric from the melt-spun filaments (column 17, 60-65 and column 19, 1-10).

Aranishi et al., does not explicitly teach the diameter of the filament, however, it is the position of the Examiner that it would be obvious to one having ordinary skill in the art to form the filament with an optimal diameter as function of desired end use (e.g., for clothing). It has been held that discovering an optimum value of a result effective

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variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980).

Aranishi et al., does not teach the claimed molecular weight of the acyl units, initial tensile modulus, glass transition temperature or CV properties, however, it is reasonable to presume that said properties are inherent to the knitted fabric taught by Aranishi et al., Support for said presumption is found in the use of like materials such as a cellulose ester fiber and the use of like processes such as forming a knitted fabric from melt-spun continuous filaments, which would result in the claimed glass transition temperature and CV properties. Applicant is invited to prove otherwise. *In re Fitzgerald* 205 USPQ 594

In addition, the presently molecular weight of the acyl units, claimed initial tensile modulus, glass transition temperature and CV properties would obviously have been present once the knitted fabric of Aranishi et al., is provided. *In re Best*, 195 UPSQ 433

### ***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to LYNDA M. SALVATORE whose telephone number is (571)272-1482. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hendricks Keith can be reached on 571-272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

December 2<sup>nd</sup>, 2009  
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/Lynda Salvatore/  
Primary Examiner

<b>Serial Number</b> 	<b>Application No.</b> 10/594,142	<b>Applicant(s)</b> TAKARADA ET AL.	
	<b>Examiner</b> LYNDA M. SALVATORE	<b>Art Unit</b> 1794	